

REMARKS

Claims 16 and 18 to 33 are now pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant respectfully requests that the Examiner acknowledge all claims for foreign priority.

With respect to page 2 of the Office Action, the objections to the drawings is respectfully traversed. In particular, the drawings were objected to under 37 C.F.R. § 1.83(a) (“Rule 83(a)”) for not showing the feature of a “plausibility check.”

While Rule 83(a) may state that a drawing is to “show every feature of the invention specified in the claims”, it further states that “features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention” should be — but are not required to be — “illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation.” Importantly, 37 C.F.R. § 1.83(a) is subject to 37 C.F.R. § 1.81 which only requires a drawing “where necessary for the understanding of the subject matter sought to be patented”. Here, the step of checking a sequence for plausibility is present in both the drawings and the specification. Step 42 in Figure 3 clearly indicates that the code sequence is checked for plausibility. *See Figure 3.* Further, support for the step of checking of plausibility can be found in the specification which states “[p]rocessing unit 12 checks macro 30 for plausibility in a step 42.” *See Specification, Page 6, lines 19-20.*

It is respectfully submitted that amended drawings are not required in view of the disclosure of the specification and the presence of the features in the drawings, as viewed by a person having ordinary skill in the art.

Nevertheless, to facilitate matters, the claim term has been removed from the claims.

With respect to page 4 of the Office Action, claims 20 and 30-33 were rejected under the first paragraph of 35 U.S.C. § 112 as to the enablement requirement.

As regards the enablement rejections of the claims, it is respectfully submitted that the Office Action's assertions and arguments presented do not reflect the standard for determining whether a patent application complies with the enablement requirement that the

specification describe how to make and use the invention -- which is defined by the claims. *See M.P.E.P. § 2164.* The Supreme Court established the appropriate standard as to whether any experimentation for practicing the invention was undue or unreasonable. *See M.P.E.P. § 2164.01* (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d. 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988)). Thus, it is axiomatic that the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *Id.* (citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988)).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. *See id.* (citing *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” *Id.*

Also, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” *Id.* (citing *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993)). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. *See id.*

In contrast to the above, however, it is respectfully submitted that the Office Action’s unsupported assertions simply do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as would be understood by a person having ordinary skill in the art in view of the disclosure of the present application, including the specification. In short, the Office Action’s

assertions are merely conclusory and do not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject matter of the rejected claims — *a proposition for which the Office bears the burden of proving a *prima facie* case as to the rejected claims.*

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of *Ex parte Reese*, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any "evidence or sound scientific reasoning" and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in *Ex parte Reese* was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. *See id.* Moreover, the Board made clear that it is "incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence," and also made clear that "[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph." *See id.* at 1222-23 (italics in original).

In the present case, the Final Office Action has not even asserted — let alone established — in a conclusory way that undue experimentation would be required. The present application plainly discloses a plausibility check and that one skilled in the art would be quite acquainted with the procedure of checking code. In this regard, Page 3, lines 10-12, Page 3, lines 24-27, Page 5, lines 15-16, and Page 6, lines 18-21, all specifically disclose checking a command sequence for plausibility. One skilled in the art would fully comprehend and be familiar with checking macro scenarios for plausibility of occurrence, and for providing further descriptions would be unnecessary and unwarranted.

Nevertheless, to facilitate matters, the claim term has been removed from the claims. It is therefore respectfully requested that the rejections be withdrawn.

Claims 16, 18 to 24, 28, and 31 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Although the rejections may not be agreed with, to facilitate matters, the claims (including claims 16 and 28) have been rewritten so as to obviate the Section rejections.

Claims 16, 18 to 20, and 22 to 29 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,611,201 ("Bishop").

While Page 4 of the Final Office Action indicates that claims 16, 18 to 20, and 22 to 32, are anticipated by Bishop, it is assumed that the Examiner was referring to claims 16, 18 to 20, and 22 to 29, since claims 30 to 32 are not addressed by the Examiner but are covered in a subsequent § 103 rejection.

As to the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. *See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." M.P.E.P. § 2112; *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, the claims have been rewritten to better clarify the claimed subject matter.

The Bishop reference discusses a system where an occupant is only given a notification only in the event that one of the vehicle parts is being recalled by the manufacturer.

In contrast, an important aspect of the presently claimed subject matter is that the command sequence is generated in a remote component, and that the command sequence is transmitted to the monitoring unit via a communication module. The Substitute Specification at page 2, lines 13 to 20, and page 3, lines 1 and 2 discloses these features. Each independent claim now includes these features. The Bishop reference simply does not identically disclose these features.

Still further, the presently claimed subject matter allows for continuous self-monitoring of characteristic curves and operating data which allows for determining and informing a user of the fact that the vehicle engine components no longer comply with predetermined limiting value or a manufacturer's warranty.

The Bishop reference simply does not identically disclose the feature in which it is determined that engine components no longer comply with a predetermined limiting value or warranty. Unlike Bishop, with the presently claimed subject matter, the occupant may be notified if a component is operating outside a predetermined value range. This represents an advanced feature (and benefit) not identically disclosed (or suggested) by the Bishop reference.

Claim 16, as presented, is therefore allowable, as are its dependent claims 18 to 24.

Claim 25 includes features like those of claim 16, as presented, and therefore claim 25, and its dependent claims 26 to 27, are allowable for essentially the same reasons.

Claims 28 and 29 also includes features like those of claim 16, as presented, and are therefore also allowable.

Claims 21 and 30 to 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishop in view of U.S. Patent No. 6,704,628 (“Fennel”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria

must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 21 and 31 depend from claim 16, as presented, and they are therefore allowable for essentially the same reasons as claim 16, as presented, since the Fennel reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Bishop reference. The Fennel reference contains no disclosure that operating data in a vehicle may be continuously monitored and checked to determine compliance with a predetermined limit or warranty.

Claim 30 depends from claim 29, as presented, and it is therefore allowable for essentially the same reasons as claim 29, as presented, since the Fennel reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Bishop reference.

Claim 32 depends from claim 25, as presented, and it is therefore allowable for essentially the same reasons as claim 25, as presented, since the Fennel reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Bishop reference.

Claim 33 depends from claim 28 as presented, and it is therefore allowable for essentially the same reasons as claim 28, as presented, since the Fennel reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Bishop reference.

Accordingly, claims 16 and 18 to 33 are allowable.

CONCLUSION

In view of the above, it is respectfully submitted that all of presently pending claims 16 and 18 to 33 are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

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Respectfully submitted,

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